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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,089	01/17/2002	Toshio Inase	218233US2	5580

22850 7590 08/18/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ANGEBRANDT, MARTIN J

ART UNIT PAPER NUMBER

1756

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/047,089

Applicant(s)

INASE ET AL.

Examiner

Martin J Angebranndt

Art Unit

1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): Claims 8 and 16 are now objected to.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: 1-4 and 9-12.Claim(s) objected to: 7, 8, 15 and 16.Claim(s) rejected: 5, 6, 13 and 14.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Martin J Angebranndt
Primary Examiner
Art Unit: 1756

Continuation of 5. does NOT place the application in condition for allowance because: The equivalence of silicon dioxide and aluminum oxide is established in the reference. Reviewing the data in table 8, which relates to example 10 the examiner notes that increased silicon dioxide content renders the medium more sensitive (10-1 to 10-5) which is desired. The examiner notes that in these examples, the aluminum oxide content is at least 50% and the presence of silicon dioxide is clearly permitted. The examiner notes also that data exists only for carbides of Ti, Ta, Si and Nb. The examiner notes that the showing is not commensurate with the scope of coverage sought, which includes even only a small amount of aluminum oxide being present. Replacing a portion of the silicon dioxide with aluminum oxide would fall within the claims and addresses the arguments of the applicant, noting that the limitation of claim 13 is met when silicon dioxide is present. Replacing only a portion of the silicon dioxide with aluminum oxide, either the mole fraction of total oxides to carbides or the relative amounts of the silicon dioxide to carbide could be easily maintained and until aluminum oxide became the dominant component, the resultant composition would be within that required by the claims. The language "oxides, carbides, and nitrides of metals such as Si, Al, Ti, Zr, Ta, Ge, etc" (7/34-35) is held to establish the equivalence of these materials, particularly when noting that they are described as possessing a high heat resistance and useful in forming protective layers. What could describe equivalence better than their physical properties, which defines related elements in the periodic table, and their utility, which is the basis for the doctrine of equivalence.


8/12/04